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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,820	07/21/2000	Alan D. Attie	960296.97290	4397

7590

01/23/2006

Nicholas J. Seay  
Quarles & Brady LLP  
P O Box 2113  
Madison, WI 53701-2113

EXAMINER

QIAN, CELINE X

ART UNIT PAPER NUMBER

1636

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/620,820	<b>Applicant(s)</b> ATTIE ET AL.	
	<b>Examiner</b> Celine X. Qian Ph.D.	<b>Art Unit</b> 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/21/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1-17 are pending in the application. Claims 13-16 are withdrawn from consideration for being directed to non-elected subject matter.

This Office Action is in response to the Amendment filed on 11/18/05.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/05 has been entered.

#### ***Response to Amendment***

The rejection of claims 1-12 and 17 under 35 U.S.C. 103(a) is maintained for reasons set forth of the record mailed on 5/17/05 and further discussed below.

#### ***Response to Arguments***

In response to the 103 (a) rejection, Applicants filed a declaration to overcome this rejection. Applicants indicate that the declaration filed by Alan D. Attie is intended to be an *In re Katz* declaration to establish that the lack of uniformity between the names on the publication and this patent application resulting from differing criteria used for determining authorship on a paper from inventorship on a patent application. Applicants assert that the Twisk et al. reference is not "by another" but is by two of the inventors involved in this patent application, thus it will obviate the instant rejection.

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The declaration filed on 11/18/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Twisk et al. reference for following reasons. The case law of *In re Katz* has established that Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). Therefore, where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from applicant (MPEP 2132.01). In the instant case, the Attie declaration asserts that two of the inventors of the instant application, Donald Gillian-Daniel and Alan D Attie, are also authors of the Twisk et al., have saw the insights from the Twisk paper and have begun work on the inventions of the claimed invention prior to the publication of Twisk. The declaration further asserts that other authors did not make inventive contributions to the subject matter claimed in this patent application. However, the declaration is not clear on what inventive contribution of the third inventor, Paul Bates, has made. It is unclear whether the laboratory work and intellectual contribution to the execution of this invention constitutes the conception of invention or reduction of practice. Further, Twisk et al. does not include Paul Bates as an author. Thus, the inventor entity of the instant application is different from the authorship of the Twisk et al. even though both have two common authors/inventors. The Attie declaration has established that the instant invention is derived from the Twisk publication, however, failed to clarify the inventive contribution of Paul Bates as the co-inventor for the instant claimed invention. Since the instant claims are rejected under 103(a), the third inventor may contribute to the difference between the instantly claimed invention and the

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disclosure of Twisk et al. If this is the case, Applicants must also provide evidence/arguments to explain why such modification is not obvious in view of the combined teaching of Twisk et al. and Jackson and Teasdale (as discussed in the previous office action). Therefore, in view of the reasons discussed above, this declaration is insufficient to overcome the 103 (a) rejection of the record. The rejection is thus maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X. Qian Ph.D. whose telephone number is 571-272-0777. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Celine X Qian Ph.D.  
Examiner  
Art Unit 1636

**CELIAN QIAN**  
**PATENT EXAMINER**

